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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,190	03/12/2004	Imad Tarabishy	V-3301-023	8186
43749	7590	08/26/2005	EXAMINER	
CHRISTOPHER PARADIES, PH.D. FOWLER WHITE BOGGS BANKER, P.A. 501 E KENNEDY BLVD, STE. 1900 TAMPA, FL 33602				BLANCO, JAVIER G
ART UNIT		PAPER NUMBER		
				3738

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/799,190	TARABISHY, IMAD
	Examiner	Art Unit
	Javier G. Blanco	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 April 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) 4 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/27/2005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of claims 1-3 in the reply filed on April 27, 2005 is acknowledged.

### ***Election/Restrictions***

2. Applicant's traversal, filed on April 27, 2005, is on the ground(s) that "A restriction requirement may only be based on two or more independent and distinct inventions claimed in one application. (35 U.S.C 121). The Examiner based the restriction requirement not on claimed inventions but merely on disclosed subject matter of the specification. This is improper and withdrawal is respectfully requested".

This is not found persuasive because the Examiner submitted an election of species requirement (as opposed to a restriction requirement). Based on the Brief Description of Drawings, Figures, and the Specification, there are several embodiments of the prosthesis, method of implanting it, and shell/cup material. As defined in MPEP 808.01(a), for an Election of Species "*it is not necessary to show a separate status in the art or separate classification*". Also, that same section of the MPEP teaches that for a multiplicity of species requiring extensive and/or burdensome search, "*a requirement for an election of species should be made prior to a search*".

Furthermore, the Office Action state: "*should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence*

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*now of record showing the species to be obvious variants or clearly admit on the record that this is the case".*

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities:

- a. Regarding claim 1, please substitute "a bone of a patient; and" (see line 5) with --a bone of patient, and--. Appropriate correction is required.
- b. Regarding claim 1, please substitute "fixedly attached to said bone and" (see line 6) with -- fixedly attached to said bone; and--. Appropriate correction is required.
- c. Regarding claim 1, please substitute "a cup," (see line 10) with --said prosthetic socket comprising a cup,--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hyde, Jr. (US 6,589,281 B2; cited in Applicant's IDS).

Referring to Figures 20-22, Hyde, Jr. discloses a joint prosthesis (total hip joint prosthesis assembly 180) comprising: (i) a shaft having a first end and a second end, said shaft comprising a body (core implant module 182 and/or modular stem 150), a neck (neck 184) attached to said body, and a ball (head 183) attached to said neck at said first end of said shaft; and (ii) a prosthetic socket (acetabular assembly 191) comprising a base 195, a cup 193, and a plurality of segments (modules/segments 192). See column 20, line 48 to column 21, line 40.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes (WO 00/48535 A1) in view of Hyde, Jr. (US 6,589,281 B2; cited in Applicant's IDS).

Referring to all Figures, specifically Figures 29 and 30, Grimes discloses a joint prosthesis comprising (a) a shaft (stem 613) having a first end and a second end, said shaft comprising a body, a neck attached to said body and a ball attached to said neck, said shaft being *sized and configured to* be receivable from the lateral side of the femur in a hole bored through the greater trochanter of a prepared femur of a patient; and (ii) a prosthetic acetabulum being *sized and configured for* attachment to a prepared area on the hip bone of the patient, said acetabulum comprising a cup, said cup having an interior surface that is *sized and configured to*

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receive said ball of said shaft for movement therein (see page 17, lines 28-31; page 30, lines 22-24).

Said shaft further comprising: (i) at least one tube (primary channel 616) having first and second open ends and extending from the bottom surface of said body and opening through said neck (see Figures 29 and 30); (ii) a second tube (primary channel 614) having an open end extending from the bottom surface of said body and a second closed end (see Figures 29 and 30); and secondary tubes (secondary channels 635-639) passing through a side wall of said body and through said second tube such that said secondary tubes are in fluid communication with said second tube (see Figures 29 and 30; see page 46, lines 7-24).

Grimes did not particularly disclose the use of a prosthetic socket (acetabulum or acetabular cup) having a plurality of segments. However, this is well known in the art. For example, Hyde, Jr. discloses a joint prosthesis (total hip joint prosthesis assembly 180) comprising a prosthetic socket (acetabular assembly 191) having a plurality of segments (modules/segments 192) in order to individually insert said segments into a joint for assembling said prosthetic socket in situ inside said joint (see Abstract; see column 20, lines 48-52; column 21, lines 10-40). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have combined the teaching of a joint prosthesis comprising a prosthetic socket having a plurality of segments, as taught by Hyde, Jr., with the joint prosthesis of Grimes, in order to individually insert said segments into a joint for assembling said prosthetic socket in situ inside said joint.

With regards to Applicant's argument "Grimes fails to establish prima facie obviousness", Grimes clearly states at page 30, lines 22-24 the desirability of total hip

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replacement comprising preparing the acetabulum in order to receive a prosthetic socket (acetabular cup). One of ordinary skill in the art would have been left to devise or select an appropriate acetabular cup.

*Response to Arguments*

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

*Allowable Subject Matter*

9. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Fahrer (DE 3704089 A1), and Iriya et al. (JP 6-218002).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

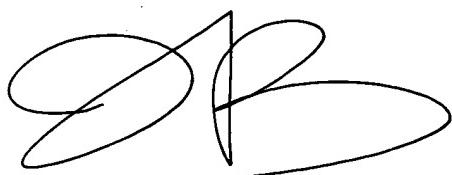
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



June 26, 2005



David H. Willse  
Primary Examiner